



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/580,047 | 05/19/2006 | Giuliano Muratore | 09952.0039 | 7573 |

22852 7590 06/20/2008
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

| |
|----------|
| EXAMINER |
|----------|

ZAIDI, SYED

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2616

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

06/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/580,047 | Applicant(s) MURATORE ET AL. | |
| | Examiner SYED ZAIDI | Art Unit 2616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

Art Unit: 2617

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 23-44, are rejected under **35 U.S.C. 103(a)** as being unpatentable over **Praestgaard**. (U.S.Publication Number 2004/0018833 A1) in view of **Leung et al.**, (U.S. Publication Number 2002/0132613 A1).

Consider claims 23, 31, 35, 39, , Praestgaard. clearly shows and disclose a method of forwarding a telephone call from a caller (180) intended to be directed to a first, fixed, telephony number (135) towards a second, mobile, telephony number (125a) in order to render an intended callee associated with the second telephony number reachable at a mobile phone (125) instead that at a fixed telephone (120a), comprising **(paragraph 0211 lines 1-10, figure # 1a, see Praestgaard, discloses telecommunication network and method, full custom application specific operating the network to reach a responder)**: having the caller placing a call to a virtual mobile telephony number (145) associated with the first telephony number **(paragraph 0212 0273)**; receiving the call at a switching apparatus (170) of a mobile telephony network (150) **(paragraph 0212, 0282-0285)**; conditioned to the fact that a call forwarding from

Art Unit: 2617

the first telephony number to the second telephony number is enabled (**paragraph 0304 lines 1-8**), routing the call from the switching apparatus to the second telephony number (**paragraph 0333 lines 1-4, see Praestgaard, discloses ICM manages the incoming calls according by routing on the other domain**); terminating the call from the caller at the second telephony number instead of at the first telephony number (**paragraph 0378 lines 1-8**), so as to establish a direct telephone call between the caller and the callee number (**paragraph 0333 lines 1-4, see Praestgaard, discloses ICM manages the incoming calls according by routing on the other domain**).

However **Praestgaard.** does not clearly disclose the responder. In the same field of endeavor **Leung et al.**, clearly shows and discloses the responder (**paragraph 0099 lines 1-9**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Praestgaard, and have a responder as taught by **Leung et al.**, thereby promoting efficiency in the system, as discussed by **Leung et al. (paragraph 0005, and 00008)**.

Consider claims 24, 32, 36, and 40, Praestgaard. and as modified by **Leung et al.**, clearly shows and discloses a packet transfer upon receiving **(paragraph 0053 lines 1-6)**, at the switching apparatus, the call from the caller to the virtual mobile telephony number, firstly routing the incoming call to the first telephony number **(paragraph 0061 lines 1-4)**.

Consider claims 25, 33, 37, and 41, Praestgaard. and as modified by **Leung et al.**, clearly shows and discloses a packet transfer apparatus having the call forwarding enabled at an apparatus (l15;120a-120n) associated with the first telephony number **(paragraph 0357 lines 1-3)**.

Consider claims 26, 34, 38, and 42, Praestgaard. and as modified by **Leung et al.**, clearly shows and discloses a packet transfer apparatus and a method, further comprising: conditioned to the fact that the call forwarding is not enabled **(paragraph 0357 lines 1-3)** and that the incoming call is answered at the first telephony number **(paragraph 0351 lines 1-3)**, terminating the call thereat **(paragraph 0357 lines 1-3)** and establishing a direct telephone call between the caller and the first telephony number **(paragraph 0366 lines 1-3)**.

Consider claims 27, 35, 39, and 43, Praestgaard. and as modified by **Leung et al.**, clearly shows and discloses a packet transfer apparatus and a method **(paragraph 0325 lines 1-2)**, comprising, in case the call is not answered at the first telephony number **(paragraph 0322 lines 1-4)**, determining the second telephony number and enabling said call forwarding **(paragraph 0357 lines 1-2)**.

Consider claims 28, 36, 40, and 44, as applied to **claims 1 and 13, Praestgaard.** and as modified by **Leung et al.**, clearly shows and discloses a packet transfer apparatus and a system, comprising, after the enabling of said call forwarding, dropping a call section from the switching apparatus to the first telephony number, while keeping the call from the caller in hold at said switching apparatus **(paragraph 0376 lines 1-18)**.

Consider claims 29-34, Praestgaard. and as modified by **Leung et al.**, clearly shows and discloses a packet transfer apparatus and a method, comprising, in which said first telephony number corresponds to a PBX network (105) having a plurality of extensions (120a,...,120n) **(paragraph 0376 lines 1-18, paragraph 0377 lines 1-3)**.

Consider claims 37 and 38, Praestgaard. and as modified by **Leung et al.**, clearly shows and discloses a packet transfer apparatus and a method, comprising, in which said first telephony number includes a number of a PBX (**paragraph 0355 lines 1-8**) network switchboard (115) (**paragraph 0318 lines 1-8**).

Consider claims 9 and 20, as applied to **claims 1 and 13, Praestgaard.** and as modified by **Leung et al.**, clearly shows and discloses a packet transfer apparatus and a method, comprising, receiving the call at the PBX (**paragraph 0376 lines 1-18**), switchboard (115), forwarding the call to (**paragraph 0377 lines 1-4**), an intended PBX network extension (120a,...,120n) and, in case the call is not answered, providing the second telephony number to a switching apparatus control (175) controlling the switching apparatus.

Conclusion

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window

Art Unit: 2617

Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Syed Zaidi whose telephone number is (571) 270-1779. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are

Unsuccessful, the Examiner's supervisor, **Nick Corsaro** can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the

Art Unit: 2617

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Syed Zaidi.
S.Z/s.z

June 06 2008

/Nick Corsaro/

Supervisory Patent Examiner, Art Unit 2617

